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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,459	11/21/2001	Mariko Egawa	TOS-125-USA-D	2290

7590 05/10/2005

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EXAMINER

CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,459

Applicant(s)

EGAWA ET AL.

Examiner

Yong S. Chong

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sept. 10, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-16, 26, 27, 29 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-16, 26, 27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/478,882.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/29/03, 6/10/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's remarks filed on August 27, 2003. Receipt of the Response to Notice of Non-Compliant Amendment and Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) both filed on September 10, 2004 is acknowledged. Permission was granted by the Office of Petitions filed on April 19, 2005. Claims 1-12, 17-25, 28, 30-31 have been cancelled, claims 32-37 withdrawn, and claims 13, 29 amended. Claims 13-16, 26-27, 29 are pending and are examined herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-16, 29 are rejected under 35 U.S.C. 103(a) as being obvious over Yu et al. (US Patent 5,385,938).

Yu et al. discloses a therapeutic treatment to alleviate symptoms of dermatologic disorders such as dry skin, psoriasis, eczema, and wrinkles are disclosed (abstract). Wrinkles are an adverse effect brought on by environmental stress. By applicant's own admission in the specification (pg. 2, paragraph 4), tobacco smoke is a prime example of such environmental stress that deteriorates the skin to cause wrinkles. Treating a subject with wrinkles would inherently treat the same subject the environmental stress caused by tobacco smoke. Yu et al. discloses an amphoteric composition to treat wrinkles. The amino acid types are cysteine, cystine, and methionine (col. 5, lines 3-4). The sulfur containing amino acid types are taurine (col. 1, line 18) and glutathione (col. 1, line 28). Alkyl alpha hydroxyacids, such as glycolic and lactic acid (col. 6, lines 18-22) in a range of 0.1 to 100%, are included in such composition (col. 13, lines 57-60). Ascorbic acid may also be incorporated into such composition (col. 8, line 44). However, Yu et al. fails to explicitly include all of these components into one composition used for the treatment of wrinkles.

It would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to incorporate amino acids (cysteine, cystine, methionine, taurine, and glutathione) and alkyl alpha hydroxyacids (glycolic and lactic acid) and ascorbic acid into one composition for treating wrinkles.

A person of ordinary skill in the art would have been motivated to include the amino acids, alkyl alpha hydroxyacids, and ascorbic acid into one composition because each component is used to treat wrinkles.

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being obvious over Yu et al. (US Patent 5,385,938) as applied to claims 13-16, 29 and further in view of Juhos et al. (US Patent 5,037,641).

Yu et al. is as discussed above, however fails to include tannins in such compositions to treat wrinkles.

Juhols et al. teach the use of tannin, catechol, and other tannin materials (col. 2, lines 21-24) found in elder blossom flower as an active ingredient in assuring the smoothness, fineness, and recovery of the original natural condition of the skin (col.1, lines 16-21). Such effects to smooth the skin will inherently reduce the appearance of wrinkles.

It would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to include tannins into a composition known to reduce wrinkles on the skin.

A person of ordinary skill in the art would have been motivated to include tannins into a composition that includes the amino acids, alkyl alpha hydroxyacids, and ascorbic acid as disclosed by Yu et al. into one composition because each component is used to treat wrinkles.

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC


SHENGJUN WANG
PRIMARY EXAMINER